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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON and WARD S. FOSTER

Appeal 2009-001742
Application 10/002,062¹
Technology Center 2400

Decided: February 19, 2010

Before JAY P. LUCAS, THU A. DANG, and CAROLYN D. THOMAS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed October 30, 2001. The real party in interest is Hewlett-Packard Development Company, LP.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 22 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a method for securely sending image data across a network and for securely printing the image data (Spec. 3, ll. 9-11). In the words of Appellants:

Image data associated with the user's identity is retrieved and encrypted by the web content running in the browser using the downloaded public encryption key, after which the encrypted image data is transmitted to the destination service, which exclusively controls the private key counterpart of the public encryption key. The encrypted image data is then decrypted by the destination service using the counterpart private key. Since the destination service has exclusive access to the private key, secure printing is performed.

(Spec. 3, ll. 6-11).

Claim 1 is exemplary, and is reproduced below:

1. From a user's browser, a secure method of image production in a web-based imaging environment, said method comprising the steps of:

accessing a destination web service;

downloading into said browser web content associated with said accessed destination web service;

downloading into said browser a public encryption key from said accessed destination web service;

retrieving image data under control of said browser;

encrypting said retrieved image data, wherein said downloaded public encryption key is utilized as part of said encrypting step;

transmitting said encrypted image data to said accessed destination web service; and

decrypting said encrypted image data by said accessed destination web service, wherein a private encryption key counterpart of said public encryption key is utilized as part of said decrypting step, said private encryption key being accessible exclusively to said accessed destination web service.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lagarde	US 5,721,908	Feb. 24, 1998
Smith	US 6,175,675	Nov. 21, 2000
		(filed Jul 23, 1998)

Schneier, *Applied Cryptography: Protocols, Algorithms, and Source Code in C*, 32-33 (John Wiley & Sons, Inc., 2nd ed., 1996).

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 10, 12 to 16, and 18 to 21 stand rejected under 35 U.S.C. § 103(a) for being obvious over Smith in view of Lagarde.

R2: Claims 11, 17, and 22 stand rejected under 35 U.S.C. § 103(a) for being obvious over Smith in view of Lagarde and further in view of Schneier.

Appellants contend that the claimed subject matter is not rendered obvious by Smith in combination with Lagarde and Schneier because Smith teaches away from the claimed invention (App. Br. 10, middle to bottom). The Examiner contends that each of the claims is properly rejected (Ans. 17, bottom).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants' Briefs. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Smith's disclosure that a "document is encrypted with the public key of a server associated with the recipient of the document, instead of with the

public key of the intended recipient” (Smith, Abstract) is a teaching away from the claimed invention.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method, device, and system for securely printing image data, such as a PDF (Spec. 16, ll. 11-12; claims, 1, 12, and 18). Appellants claimed invention includes downloading a public key into a web browser, using the public key for document encryption, and decrypting the document with a private key. (*See* claim 1.)

Smith

2. The Smith reference discloses converting and formatting a document using a dynamic document conversion server (DDCS) (col. 4, l. 66 to col. 5, l. 2 and ll. 33-35), downloading a public key (col. 6, ll. 28-30; Fig. 2a), using a public key for document encryption (*id.*), sending an encrypted document (*id.*), and decrypting the document with a private key (*id.* at ll. 37-39).

Lagarde

3. The Lagarde reference discloses a World Wide Web browser (col. 9, ll. 10-11) that controls agents for purposes of downloading data (*id.* at l. 66 to col. 10, l. 4; Abstract; Ans. 15, top.).

Schneier

4. The Schneier reference discloses a “hybrid cryptosystem” (p. 33, ¶ 5) in which the system generates a session key, uses the public key of the recipient to encrypt the session key, and sends the session key and data to the destination (p. 33, ¶¶ 6-9; Ans. 11, top to middle). At Schneier’s destination, the private key counterpart decrypts the session key, and the session key, in turn, decrypts the data (*id.*).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Appellants have raised the issue of Smith teaching away from the claimed invention. Our guiding court has held “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claims in the ’198 application.” (*In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 4 to 11 of the Examiner's Answer. In opposition, Appellants present several arguments.

*Arguments with respect to the rejection
of claims 1 to 10, 12 to 16, and 18 to 21
under 35 U.S.C. § 103(a) [R1]*

Appellants argue that Smith teaches away because Smith discloses that providing a public key of a server (located behind a firewall) of a recipient of a document is preferable to providing an unsecure public key (App. Br. 10).

In reply, the Examiner points out in the Answer that claim 1 recites, in relevant part, a “public encryption key,” and not a “public key of an intended recipient,” as argued by Appellants (Ans. 14, middle). The Examiner notes that Smith's disclosure of “an intended recipient” is similar to Appellants' disclosure of a “production device” (*i.e.*, a printer) (*id.*), which is not recited in claim 1. (*See* claim 1; *but see* claims 3 and 4.) The Examiner finds that Appellants' claim limitation “public encryption key of the accessed destination web service” (claim 1) reads on Smith's public key of the server (Ans. 14, middle).

We agree with the Examiner's analysis for the following reasons. We find that Appellants have invented a method, device, and system for securely printing image data, such as a PDF (FF#1). Appellants' claimed invention includes downloading a public key into a web browser, using the public key for document encryption, and decrypting the document with a private key (*id.*). In comparison, the Smith reference discloses converting and

formatting a document using a dynamic document conversion server (DDCS), downloading a public key, using a public key for document encryption, sending an encrypted document, and decrypting the document with a private key (FF#2).

Appellants have raised the issue of a teaching away (App. Br. 10, middle to bottom). Our guiding court has held “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claims in the ’198 application.” (*In re Fulton*, cited above).

Contrary to Appellants’ argument, we find that the Smith reference does not denigrate (*i.e.*, “criticize, discredit, or otherwise discourage” in accordance with the teachings of *In re Fulton*, cited above) the method of claim 1. We adopt the Examiner’s finding (*see* Ans. 14, middle) that Appellants have argued features of Smith (*i.e.*, Smith’s firewall and the “intended recipient,” or a printer) not included in the limitations of claim 1. In particular, the portion of Smith argued by Appellants discloses a preference for placing a server with a public key behind a firewall to ensure that the public key cannot be downloaded by any other parties than the party intended to receive an encrypted document. (*See* col. 6, ll. 35-37.) Such a preference, as disclosed in Smith, does not “criticize, discredit, or otherwise discourage” (*see In re Fulton*, cited above) the method of claim 1.

Further, we note that Appellants have placed no limitations or restrictions on the claimed “public encryption key” since claim 1 does not recite a firewall or “an intended recipient.” (*See* claim 1.) Thus, the presence or absence of either a firewall (*see* col. 6, ll. 31-32) or “an intended

recipient” in the Smith reference is unrelated to the limitations of claim 1. We find that the skilled artisan would have understood Smith’s public key to be similar to Appellants’ claimed “public encryption key” and Smith’s server to be similar to Appellants’ claimed “accessed destination web service.” Since Appellants have argued features of Smith not included in claim 1 and Appellants’ “public encryption key” and “accessed destination web service” do indeed read on Smith’s public key and server, respectively, we are unconvinced by Appellants’ teaching away argument. Accordingly, we find no error in the Examiner’s analysis.

Next, Appellants argue that there is no motivation to combine the Smith and Lagarde references as proposed by the Examiner (App. Br. 11, middle).

In reply, the Examiner states a rationale for combining the references (Ans. 5, bottom). Specifically, the Examiner says “it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the secure document transmitting of Smith with the browser of Lagarde in order to affect web server data access over the Internet.” (*Id.*).

In accordance with the teachings of *KSR Int’l Co. v. Teleflex, Inc.*, cited above, the Examiner has stated above an “articulated reasoning with some rational underpinning” (*id.*) for combining the Smith and Lagarde references (Ans. 5, bottom). We note that the premise of Appellants’ argument in opposition to the Examiner’s proposed combination is actually a legal conclusion (*i.e.*, there would have been no reason to combine the Smith and Lagarde references). Since Appellants’ argument is merely a conclusory legal statement, we find unconvincing Appellants’ argument. Accordingly we find no error.

Appellants contend that the Examiner's proposed modification (*i.e.*, incorporating Lagarde's browser in Smith's system) would have rendered the Examiner's proposed combination of prior art elements unsatisfactory for the prior-art invention's intended purpose (Ans. 12, top).

Again, we are unconvinced by Appellants' argument that the combination of prior art elements renders the prior invention unsatisfactory for its intended purposes (*id.*) since this premise is a legal conclusion. Appellants have presented no reason why incorporating a browser in Smith's system would have rendered the proposed combination of prior art elements unsatisfactory for prior art invention's intended purpose (*id.*). Accordingly, we find no error.

Regarding claims 1 and 10, Appellants argue: "Lagarde fails to suggest retrieving image data under control of a web browser and transmitting the image data to a destination web service, since Lagarde teaches that agents at a server perform processing tasks in lieu of a browser application." (App. Br. 12, bottom; App. Br. 14, middle to bottom).

In reply, the Examiner points out that the agents argued by Appellants above are controlled by Lagarde's browser (FF#3). We adopt the Examiner's finding that the browser agents control the downloading of image data is similar to the claim language (*id.*). Accordingly, we find no error.

Appellants make arguments under two separate subheadings for each of independent claims 12 and 18. (*See* App. Br. 14, bottom to 22, middle.) However, we find that claims 12 and 18 contain substantially similar subject matter as claim 1. We note that Appellants' arguments that Smith teaches away (App. Br. 15, bottom to 16, middle); there is no motivation for

combining the references (App. Br. 16, middle); the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose (App. Br. 17, middle); and that Lagarde fails to suggest encrypting image data and transmitting the image data to a destination web service since Lagarde's agents perform processing tasks in lieu of its browser are the same as the arguments for claim 1. Accordingly, we need not address these arguments again. Instead, we refer Appellants to the above-stated analysis of claim 1. (*See supra.*)

Dependent claim 16 recites, in relevant part, "said production options include an option to produce securely, the option to print securely providing a secure transmission of data to said destination web servicer."

Regarding claim 16, Appellants contend that claim 16 is "one of the narrowest claims currently pending." (App. Br. 18, bottom).

We find unconvincing Appellants' argument that the rejection of claim 16 is improper because the claim is "one of the narrowest claims currently pending," (App. Br. 18, bottom) since Appellants fail to distinguish the claim language over the cited prior art. Accordingly, we find no error concerning the Examiner's analysis of claim 16.

*Argument with respect to the rejection
of claims 11, 17, and 22
under 35 U.S.C. § 103(a) [R2]*

Appellants make mere allegations of patentability regarding claims 11, 17, and 22 (App. Br. 24, top to middle). Mere allegations of patentability, such as those presented by Appellants in the Briefs (*id.*), are not considered a persuasive form of argumentation. (*See* 37 C.F.R. § 1.111(b).) Accordingly, we find no error.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 22.

DECISION

The Examiner's rejections [R1, R2] of claims 1 to 22 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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